77. (New) The method according to claim 63, wherein the WHEN portion is used to monitor for an occurrence of at least one event.

REMARKS

I. GENERAL

Originally-filed claims 1-37 have been canceled, without prejudice. New claims 38-77 have been added. Accordingly, claims 38-77 are now under consideration in the above-identified application. It is respectfully submitted that no new matter has been added.

II. THE REJECTIONS UNDER 35 U.S.C. §§ 102(e) AND 103(a) SHOULD BE WITHDRAWN

Claims 1, 3-7, 10-18, 21-24, 29-32 and 37 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,006,218 to Breese et al. (the "Breese Patent"). Claims 2, 8, 9, 19, 20, 25-28 and 33-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Breese Patent. Since originally-filed claims 1-37 have been canceled above without prejudice, the rejections of these claims under 35 U.S.C. §§ 102(e) and 103(a) are now moot, and should therefore be withdrawn.

III. NEW CLAIMS 38-77

As indicated above, new claims 38-77 have been added to clearly describe Applicants' claimed invention, and are now provided for the Examiner's consideration. It is respectfully asserted that new independent claims 38 and 58, and claims 39-57 and 59-77 which depend from claims 38 and 58, respectively, are in no way taught or suggested, much less disclosed by the Breese Patent.

In order to render a claim anticipated under 35 U.S.C. § 102, a single prior art reference must disclose each and every element of the claim in exactly the same way. *See* Lindeman Machinenfabrik v. Am Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103, not only must the prior art teach or suggest each element of the claim, the prior art must also suggest combining the elements in the manner contemplated by the claim. *See* Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir.), cert. denied 111 S.Ct. 296 (1990); *see* In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990).

Applicants' invention, as recited in new independent claim 38, relates to an apparatus for monitoring information on a network. The apparatus comprises, *inter alia*,

> a processing device executing the monitoring module to transmit at least one instruction to the network ... **requesting a performance of a monitoring operation to monitor the information on the network as a function of the predetermined criterion, the processing device is**

adapted to receive data from the network based on at least one result of the monitoring operation.

New independent claim 58 relates to a method which includes similar recitations.

The Breese Patent relates to a method and system for retrieving information and/or processing the retrieved information as a function of a user's estimated knowledge. (See Breese Patent, column 1, lines 8-12). With these method and system, estimates of the probability that the item being searched is already known to the user, or items listed in the search results are known to the user, are generated. (See Id., column 2, lines 25-29). The generated knowledge probability estimates are then used for ranking or re-ranking the search results. In this manner, the method and system of the Breese Patent adjusts or corrects the results of various search engines. This is apparently done by factoring into the search results and the ranking thereof, a consideration of the probability that the user already knows about certain data items. (See Id., column 2, lines 29-36).

As described in the Breese Patent, these method and system can be used when making recommendations to the user in response to a user initiated information request or after monitoring user's actions for a period of time (in order to estimate probabilities and provide recommendations). The monitored actions may involve the user accessing the Internet site. The recommendations or suggestions can be made to the user regarding other Internet sites or data items which may be unknown but interesting to the user. (See Id., column 3, lines 23-31).

In contrast, Applicants respectfully assert that the Breese Patent in no way teaches or suggests, much less discloses an apparatus and method for monitoring information on a network in which **the information on the network is monitored as a function of the predetermined criterion**, as explicitly recited in new independent claims 38 and 58. In the Office Action, the Examiner alleges that the Breese Patent teaches "an apparatus for monitoring and exploring data on a network." (See Office Action, page 2, paragraph 3). As discussed above, the method and system of the Breese Patent can be used when making recommendations to the user after *monitoring user's actions* for a period of time. (See Breese Patent, column 3, lines 23-26; *emphasis added*). Indeed, the method and system of the Breese Patent checks user input to perform *a search*, but does not **monitor** any information on the network (See Breese Patent, Fig. 4b, step 222). The search performed by the system and method of the Breese Patent cannot be equated to the monitoring of the information on the network, as recited in Applicants' claimed invention. Accordingly, the Breese Patent (either in these sections or in any other section) does not teach or suggest that the information is monitored on the network, much less that the information is monitored on the network as a function of the predefined criterion, as recited in new independent claims 38 and 58. It follows that the Breese Patent does not teach or suggest the apparatus or method in which **information is received from the network based on at least one result of the monitoring operation/step**, as also recited in independent

claims 38 and 58 of the above-identified application.

With respect to claims 39-57 and 59-77, these claims depend from new independent claims 38 and 58, respectively. Thus, the arguments discussed above with respect to independent claims 38 and 58 also apply to claims 39-57 and 59-77. In addition, the Breese Patent does not teach or suggest any of the recitations provided in claims 39-57 and 59-77.

For example, the Breese Patent provides absolutely no teaching or suggestion that **the predefined criterion is a rule-based criterion**, as recited in claims 42 and 62. In particular, the Examiner believes that the Breese Patent discloses that "the instructions specified by one or more ... users are in the form of monitoring/probing rules ... ." (See Office Action, page 3, lines 13-15). In support of this allegation, the Examiner points to column 3, lines 23-32 and column 7, line 59 to column 8, line 14 of the Breese Patent. After reviewing these sections and other sections of the Breese Patent, Applicants respectfully submit that the Breese Patent does not even mention, much less teach or suggest that the predetermined criterion is a rule-based criterion, as recited in claims 42 and 62. Indeed, the Breese Patent nowhere discloses any criterion that is rule-based. Moreover, the Breese Patent does not even mention that **this rule-based criterion includes a WHEN portion and/or an IF portion, as well as a THEN portion**, and that **the THEN portion includes a probing action**, as also recited in claims 43 and 63.

Accordingly, the Breese Patent does not teach or suggest, much less disclose the subject matter recited in new independent claims 38 and 58, and claims 39-57 and 59-77 which depend from claims 38 and 58, respectively. Therefore, an affirmation of patentability is respectfully requested for pending claims 38-77.

IV. CONCLUSION

In light of the foregoing, Applicants respectfully submit that pending claims 38-77 are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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